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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,565	06/05/2000	Yoshinori Miyazawa	1046.1214/JDH	7602
21171	7590	08/28/2007	EXAMINER	
STAAS & HALSEY LLP			NGUYEN, DUSTIN	
SUITE 700				
1201 NEW YORK AVENUE, N.W.			ART UNIT	
WASHINGTON, DC 20005			PAPER NUMBER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/587,565

Applicant(s)

MIYAZAWA, YOSHINORI

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1, 2, 4-8, 10-14, 16-18 are presented for examination.
2. The indicated allowability of claims 1, 2, 4-8, 10-14 and 16-18 is withdrawn. A new non-final Office Action is indicated as below.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 1, 2, 7, 8, 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 1, 2, 7, 8, 13 and 14:

- ☐ **does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list.**

Applicant did not provide support for the above limitation as amended on 12/13/2004.

Therefore, claims 1, 2, 7, 8, 12 and 13 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed limitations.

(2) Claims 1, 2, 7, 8, 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of

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enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 1, 2, 7, 8, 12 and 13:

- ☐ **does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list.**

Undue experimentation would be needed to make an extracting unit of E-mail terminal device to **not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list.**

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4 – 8, 10 – 14, 16 – 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara [ US Patent No 5,938,725 ], in view of Kikinis [ US Patent No 6,785,710 ].

6. As per claim 1, Hara discloses the invention as claimed including an E-mail terminal device comprising:

a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time by a predetermined single mail address [ col 2, lines 29-34, and lines 64-67; col 3, lines 51-60; and col 4, lines 48-56 ];

a selecting unit which displays the at least one extracted mail address as a candidate for a reply destination from which a specified reply destination can be selected [ col 3, lines 14-28; and col 4, lines 2-11 ], where the specified reply destination is used for transmitting a reply in response to the E-mail received [ i.e. transmitting message to determined destination ] [ S5, Figure 2; and col 7, lines 1-10 ].

Hara does not specifically disclose

an extracting unit which automatically extracts at least one mail address of the mailing list contained in a text of the E-mail received when the reply destination mail address is the address of the mailing list, and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list.

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Kikinis discloses

an extracting unit which automatically extracts at least one mail address of the mailing list contained in a text of the E-mail received when the reply destination mail address is the address of the mailing list, and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list [ i.e. parser retrieves words or phrases in the body of the message ] [ Abstract; and col 6, lines 1-14 ].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Kikinis because the teaching of Kikinis on parsing the body of the message would provide automatically choose and insert address in the appropriate field box of an e-mail reply to an original message, or at least provide selectable options for such addresses to an agent or other user [ Kikinis, col 2, lines 34-43 ].

7. As per claim 2, it is rejected for similar reasons as stated above in claim 1.

8. As per claim 4, Hara discloses a storage unit including a mail address book by which whether or not the reply destination mail address extracted from the mail header of the E-mail received is the address of the mailing list, can be judged [ col 1, lines 10-20 and lines 29-37 ].

10. As per claim 5, Hara discloses a processing unit which stores [ claim 1, lines 3-4; and col 2, lines 58-59 ], if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown

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in the mail address book in a format of corresponding to the mail address [ col 1, lines 35-37; and col 3, lines 56-59 ].

11. As per claim 6, Hara discloses a display unit which displays, when visibly displaying all the extracted mail addresses as the reply destination candidates, the name of the mail address extracted from the text of the received E-mail and unregistered in the mail address book as the name unknown in the format of corresponding to the mail address [ Figure 4 ].

12. As per claims 7, 8, 10-12, they are method claimed of claims 1, 2, 4-6, they are rejected for similar reasons as stated above in claims 1, 2, 4-6.

13. As per claims 13, 14, 16-18, they are program product claimed of claims 1, 2, 4-6, they are rejected for similar reasons as stated above in claims 1, 2, 4-6.

14. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

*Conclusion*



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Flynn Nathan can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dustin Nguyen  
Examiner  
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